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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/023,232	02/13/1998	ANN MONOSOV	312762001530	6662

25225 7590 11/16/2004  
MORRISON & FOERSTER LLP  
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SAN DIEGO, CA 92130-2332

EXAMINER
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WEHBE, ANNE MARIE SABRINA

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/023,232

**Applicant(s)**

MONOSOV ET AL.

**Examiner**

Anne Marie S. Wehbe

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18,20-25,27,28,30-37,42-49 and 54-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18,20-25,27,28,30-37,42-49 and 54-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Applicant's response and terminal disclaimer filed on 4/9/04 have been entered. Applicant's surrender of the original patent and statement under 37 CFR 1.178(b) are acknowledged. Claims 1-18, 20-25, 27-28, 30-37, 42-49, and 54-61 are currently pending in this reissue application.

#### ***Double Patenting***

The rejection of claims 1-2, 8-13, 15, 17, 20, 22, 24, 27-28, 30, 33-34, 37, 42, 45-46, 49, 54, 57-58, and 61 for obviousness type double patenting over claims present in U.S. Patent No. 5,491,284 is withdrawn in view of applicant's submission of a terminal disclaimer.

#### ***Amendments***

Applicant's amendment to the claims filed on 1/2/04 does not comply with 37 CFR 1.173(b-d). In reissue applications, all markings showing amendments to patent claims must be based on the language present in the patented claims, and not on previous amended versions of the patent claims in the reissue, see specifically 37 CFR 1.173(d). Further, all claims added in the reissue application which were not present in the patent, whether amended or not, must be underlined.

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A corrected copy of the claims as amended submitted under 37 CFR.1.173(b-d) is required in response to this office action.

***Oath/Declaration***

In accordance with **37 CFR 1.175(b)(1)**, a supplemental reissue oath/declaration under **37 CFR 1.175(b)(1)** must be received before this reissue application can be allowed. Specifically, a supplemental reissue declaration is required according to MPEP 1414.01 and 37 CFR 1.175(b)(1) because the claims were amended post-filing of the original signed reissue declaration.

Claim 1-18, 20-25, 27-28, 30-37, 42-49, and 54-61 are rejected as being based upon a defective reissue declaration under **35 U.S.C. 251**. See **37 CFR 1.175**. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

“Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant.”

The applicant's representative, Kate Murashige, was contacted by the examiner on 10/5/04. The examiner indicated that the amendment to the claims was not in conformance with 37 CFR 1.173(b-d) and that a supplemental declaration under

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37.1.175(b) was further required to place the reissue application in condition for allowance.

**THIS ACTION IS MADE FINAL** in accordance with MPEP 1444. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication from the examiner should be directed to Anne Marie S. Wehbé, Ph.D., whose telephone number is (571) 272-0737. The examiner can be reached Monday- Friday from 10:30-7:00 EST. If the examiner is not available, the examiner's supervisor, Amy Nelson, can be reached at (571) 272-0804. For all official communications, the technology center fax number is (703) 872-9306. For informal, non-official communications only, the examiner's direct fax number is (571) 273-0737.

Dr. A.M.S. Wehbé

ANNE M. WEHBE' PH.D  
PRIMARY EXAMINER

